



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants : Konstanze SAATHOFF et al.)
Appln. No. : 09/554,343)
Filed : September 14, 1999)
§ 371 Date : December 6, 2000)
For : MOTOR-DRIVEN SCREW DRIVER)

Group Art Unit: 3723

Examiner: D. Meislin

RECEIVED

MAR 12 2003

TECHNOLOGY CENTER R3700

REPLY BRIEF UNDER 37 C.F.R. 1.193(b)(1)

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This Reply Brief is in response to the Examiner's Answer dated January 9, 2003, the period for reply extending until March 10, 2003 (March 9, 2003 being a Sunday).

In the Examiner's Answer, the Examiner maintains the grounds of rejection advanced in the final rejection with regard to Issue and provides arguments in support thereof.

Appellants note that this Reply Brief is being filed under 37 C.F.R. 1.193(b)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellants note that they are addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT

First Issue

On Page 2, section 5 (*Summary of the Invention*) of the Examiner's Answer, the Examiner has objected to certain portions of Appellants' summary as not supported. In this regard, Appellants note that, while the original disclosure included lines 23 and 24 of page 3, which were subsequently deleted by a Preliminary Amendment for reasons related merely to form, the subject matter was not withdrawn from the specification. However, if it would be of assistance, Appellants note that original claim 1 provides express support in the originally submitted application for the above-noted statement, as well as page 1, lines 3 and 11 - 26.

Appellants caution, however, that the above-noted statement, like the other objected statements of the Summary, was not reproduced verbatim from the original specification, but is a summary of the subject matter disclosed by the identified portions of the disclosure. That is, page 1, line 3 provides support that the invention is directed to a motor-driven manual wrench, lines 11 - 15 disclose the drive, and lines 17 - 26 disclose the head and an output shaft having an end formed to receive sockets having a desired wrench size.

Further, while the Examiner has objected to lines 4 and 5 of the Summary of the Invention not being supported by the page 3, lines 25 - 33 of Appellants' specification, Appellants again note that their statements are intended to *summarize* the subject matter of

the identified portions of the disclosure, and unless provided in quotation marks, should not be considered to be verbatim from the disclosure. Appellants submit that the page 3, lines 25 - 33 of Appellants' disclosure provides support for the statement "In an exemplary embodiment of the invention, the motor driven manual wrench, in addition to the motor drive, includes a ratchet drive with a torque limiter arranged as in a conventional torque wrench" (which was misquoted by the Examiner in the Examiner's Answer as "... arranged in a conventional torque wrench."). While Appellants acknowledge that the term "conventional" was not stated in the noted portion of Appellants' disclosure, it is apparent that this is the gist of Appellants' disclosure "as they are provided in torque wrenches."

Finally, Appellants note that, while the statements summarizing the disclosure of page 9, lines 8 - 23 do not utilize the express terms of the disclosure, the statements are supported by this portion of the original disclosure.

Accordingly, Appellants submit that the Summary of the Invention provided in Appellants' Appeal Brief is accurate and fully supported by Appellants' original disclosure.

Second Issue

On Page 3, section 7 (*Grouping of Claims*) of the Examiner's Answer, the Examiner asserts that she does not agree that the claims do not stand or fall together. As the rejections are based solely upon formal matters, Appellants will acquiesce that the claims on appeal stand or fall together.

Third Issue

Appellants' submit that Appellants' Appeal Brief points out express disclosure (by page and figure) in the originally submitted specification in support of their position that the specification and claims are fully in compliance with the requirements of 35 U.S.C. § 112, first and second paragraphs.

Appellants note that, not only does the Examiner merely repeat her arguments from the final rejections, she has not provided any arguments countering Appellants' specific identification of disclosure in support of the instant application being in compliance with all requirements of 35 U.S.C. § 112, first and second paragraphs. The Examiner merely states that "arguments are insufficient to overcome a deficient specification and drawings." (Examiner's Answer page 3, section 11 (*Response to Argument*), first paragraph).

Appellants submit that, as they have specifically identified portions of the original disclosure and drawings in support of their position, their position in no way relies only on arguments. Further, as the Examiner's Answer has not countered any of Appellants' arguments with regard to the specific support in the original disclosure and drawings, Appellants submit that the Board should find in favor of Appellants and reverse the Examiner's decision to finally reject the claims and remand the application to the examining group for early allowance.

Appellants traverse the Examiner's statements that the originally submitted disclosure

does not support their position that the invention is a combination of two well known types of wrenches, i.e., a torque wrench and a motor driven wrench. As disclosed on Specification page 3, lines 26 - 28, the invention combines “the motor drive normally provided in the manual wrench with an additional ratchet drive containing its own torque limiter as they are provided in torque wrenches.” In this way, without removing the wrench from a bolt head, the motor drive can be used to drive a bolt to a first degree of tightness (less than the desired torque limiter setting on the ratchet drive), and, upon achieving the first degree of tightness, the ratchet drive is utilized to manually drive the bolt until the torque set by the torque limiter is achieved. (Specification page 3, line 34 - page 4, line 6).

In light of the foregoing, Appellants submit that it is certainly apparent that, while the individual drives are known, the invention lies in the combination of these two drives into a single apparatus.

Further, Appellants again submit that there is no contradiction in reciting the instant invention as a “motor-driven manual wrench.” As Appellants’ original disclosure provides explicit support for this term, *see, e.g.*, page 3, lines 19 - 21, Appellants submit that one ordinarily skilled in the art would understand the subject matter of the pending claims and be able to readily ascertain the scope of the claims.

Still further, as set forth in Appellants’ Appeal Brief, the original disclosure provides express support for each the subject matter of each claim, including those noted by the

Examiner, i.e., claims 2, 3, 7 - 12, and 14 - 16, and one ordinarily skilled in the art reviewing the specification and claims would be able to readily ascertain the scope of these claims. Appellants also note that the Appeal Brief addressed the Examiner's concerns with regard to the above-noted claims, as well as to line 3 - 7 of claim 6, and the structure of the recited "flat" output element by pointing out the specific portions of the original disclosure providing the support for this subject matter. Because the Examiner's Answer has not countered Appellants' arguments in this regard, Appellants submit that the Board should find in favor of Appellants and reverse the Examiner's decision to finally reject the claims and remand the application to the examining group for early allowance.

As the drawing objection is not appealable subject matter, Appellants will not address the Examiner's arguments in this regard.

For the foregoing reasons, Appellant submits that the Examiner's decisions to finally reject claims 1 - 18 under 35 U.S.C. § 112, first and second paragraphs, should be reversed, and the application should be returned to the examining groups for early allowance.

CONCLUSION

For the reasons expressed above, Appellant respectfully requests that the grounds of rejection advanced by the Examiner be reversed. Appellants further request that the application be returned to the Examining Group for prompt allowance.

This Reply Brief is submitted herewith in triplicate for the convenience of the Board.

Although neither a fee nor an extension of time is believed to be due with this Reply Brief, if an extension of time is necessary, Appellants respectfully request an extension of time under 37 C.F.R. 1.136(a) for as many months as would be required to render this submission timely. Further, the Commissioner is hereby authorized to charge any additional fee due to Deposit Account No. 19-0089.

Respectfully submitted,
Konstanze SAATHOFF et al.



Neil F. Greenblum

Reg. No. 28,394

35,813

March 10, 2003
GREENBLUM & BERNSTEIN, P.L.C.
1941 Roland Clarke Place
Reston, VA 20191
(703) 716-1191